





U.S. Patent App. Ser. No. 09/304,552  
Attorney Docket No. 10191/3248 (formerly PHN 16,914)  
Reply Brief to Supplemental Answer of July 3, 2006

[10191/3248]

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

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In re Application of:

Peter J. T. Van Ravenstein

For: OBSERVATION SYSTEM

Filed: May 4, 1999

Serial No.: 09/304,552

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**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

SIR:

Appellant submits the present Reply Brief (the two-month response date for which is September 5, 2006 (since September 3, 2006 is a Sunday, and since September 4, 2006 is a federal Holiday) to the SUPPLEMENTAL Examiner's Answer mailed on July 3, 2006 ("the Supplemental Answer"). Although not required, two duplicate copies of this Reply Brief are also being submitted herewith as a courtesy to the Patent Office.

For the reasons set forth in the Appeal Brief and those set forth below, it is again respectfully submitted that the final rejections of claims 1 to 15 should be reversed.

**REMARKS**

In response to the Supplemental Answer of July 3, 2006, the following is submitted:

**A. Claims 1 to 15**

**The Rejections Under 35 U.S.C. § 103(a)  
That Claims 1 to 15 Are Obvious Over  
“Cotton” in view of the “Herzog” Reference**

**Claims 1 to 15**

As to obviousness, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Also, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 1 to 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Cotton et al., U.S. Patent No. 4,640,110, in view of Herzog et al., U.S. patent No. 4,703,356.

It is first noted that the Supplemental Answer at page 4 does not even identify a motivation for combining the Cotton and Herzog references. The Examiner simply does so without any rationale for doing so, except to assert that doing so provides the claim features. In fact, at page 9, the Examiner essentially asserts that the suggestion is provided by the fact that because Herzog "suggests" that the systems are applicable to other systems, this is sufficient to provide the motivation to provide the claimed subject matter. This does not represent the requisite suggestion or motivation.

*In this regard, it is respectfully submitted that even if there were some motivation to apply "Herzog" to the primary reference of "Cotton" (which is not conceded because there is none), a person having ordinary skill in the art would still not obtain the claimed subject matter. This is because even if it were taken into account that the manual recording of images of "Herzog" could be done when an alarm occurs according to "Cotton", the person having ordinary skill in the art may (for the purposes of this discussion) arrive at the solution that a sequence is recorded and that according to "Herzog", the sequence is repeated after a play loop is depressed.*

*It is respectfully submitted, however, that there is no disclosure or suggestion that a sequence is displayed upon occurrence of the event, as asserted in the Final Office Action -- and the Supplemental Answer has not properly addressed this deficiency except to conclusorily assert otherwise.*

Thus, claim 1 is to an observation system having an observation monitor unit, which includes means for recording a plurality of images including an image at a time of the event, and means for repeatedly displaying a sequence formed by the plurality of images upon the occurrence of the event.

The Supplemental Answer and the Office Actions to date simply assert that the Herzog reference "teach[es] means for repeatedly displaying the sequence formed of [a] plurality of images" and further asserts that it would have been obvious for one of ordinary skill in the art to incorporate the display of Herzog into the observation system of Cotton for the purpose of repeatedly displaying the sequence of images.

It is again submitted that the asserted motivation to combine the primary Cotton reference with the secondary Herzog references lacks adequate foundation as to the legal

standards discussed below, and the it is respectfully submitted that the Supplemental Answer did not properly address this deficiency.

As previously explained the Appeal Brief, in the method referred to in the secondary Herzog reference, a recording loop begins *by the manual operation of a button*. (See Herzog, col. 4, lines 32 to 47). The recording fills the available memory space and may be repetitively replayed by manually pressing another “play loop” button. (See Herzog, col. 5, lines 12 to 24). What is missing here is any evidence as to how this manual frame repetition method in any way discloses or suggests the feature of repeatedly displaying a sequence formed by the plurality of images upon the occurrence of the event as provided for in the context of claim 1.

Even if there were some motivation for the skilled practitioner to apply the purported disclosures of Herzog reference to those of the primary Cotton reference – which is not admitted – *the Supplemental Answer has not refuted the fact that the manual repeat loop of Herzog does not lend itself to the event based repetition claimed because the Herzog process merely prescribes continuously filling an available memory space with video information upon the pressing of a button (and then making this video data available for repetitive display) without regard to the usefulness of recording a particular frame*. In contrast, the Cotton reference only refers to recording a limited amount of video information upon the activation of an alarm. In this regard, the Cotton reference specifically explains that:

By using the timed relationship between switch closures, and the sequential relationship between switch closures to define alarm events, activities of employees which are unacceptable will be monitored and recorded, without recording an undue number of normal transactions.

(See Cotton, col. 6, lines 12 to 17)(emphasis added).

In light of the incompatible elements of the processes referred to in the primary Cotton and secondary Herzog references, a person having ordinary skill would not be motivated to combine the references to provide the presently claimed subject matter and its benefits, as explained in the specification.

Accordingly, claim 1 is allowable.

Regarding claims 2 to 4, 7, 10 and 13, which depend from claim 1, it is respectfully submitted that these claims are allowable for at least the same reasons as claim 1.

Independent claims 5 and 6 as presented also include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

Claims 8, 11 and 14 depend from claim 5 and are therefore allowable for the same reasons as claim 5.

Claims 9, 12 and 15 depend from claim 6 and are therefore allowable for the same reasons as claim 6.

As further regards all of the obviousness rejections discussed herein, in rejecting a claim under 35 U.S.C. § 103(a), the *Office* bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also suggest combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Moreover, the Supplemental Answer has not properly addressed the fact that the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” (See Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998)). It is again respectfully submitted that, as explained above, the references relied on, whether taken alone or combined, do not suggest in any way modifying or combining the references so as to

provide the presently claimed subject matter for addressing the problems and/or providing the benefits discussed in the specification.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the unsupported assertions of the Supplemental Answer and the Final Office Action that it would have been obvious to modify the reference relied upon does not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Supplemental Answer and the Final Office Action reflect a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the Supplemental Answer and the Final Office Action reflect hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not even the case here, there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed”, stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. *With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed.* In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

(See In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Federal Circuit 2000) (italics added)).

Here again, it is believed that there have been no proper findings in the Supplemental Answer or the Office Actions to date to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the references relied upon, whether taken alone or combined, makes plain that they simply do not describe the features discussed above of the claims as now presented.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the references so as to provide the subject matter of the claims and its benefits.

In short, there is no evidence that the references relied upon, whether taken alone or otherwise, would provide the features of the claims discussed above. It is therefore respectfully submitted that the claims are allowable for these reasons.

As further regards all of the obviousness rejections of the claims, it is respectfully submitted that not even a *prima facie* case has been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the



time the claimed subject matter of the present application was made. (See *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)). It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (See *In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and this Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper *prima facie* unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

It is therefore respectfully requested that the obviousness rejections be reversed, since claims 1 to 15 are allowable.

**B. Claims 1 to 3, 5 and 6**

**The Rejections Under 35 U.S.C. § 103(a)  
That Claims 1 to 3, 5 and 6 Are Obvious  
Over “Tapp” in view of “Quirk”**

**Claims 1 to 3, 5 and 6**

Claims 1 to 3, 5 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Tapp, U.S. Patent No. 5,657,076 in view of the British patent document to Quirk, GB 2 203 586.

*It is first noted that the Supplemental Answer at page 5 does not even identify a motivation for combining the Tap and Roger references. Again, the Examiner simply does so without any rationale for doing so, except to assert that doing so provides the claim features.*

In particular, regarding the primary Tapp reference, the Supplemental Answer and the Office Actions to date essentially admit that the reference does not disclose repeatedly displaying a sequence as provided for in the context of claim 1. The secondary Quirk reference simply does not cure the critical deficiencies of the primary Tapp reference.

In particular, the “repeated images” referred to in the Abstract of the Quirk reference are repeated ***spatially and not temporally*** as is clearly stated on page 1, lines 23 to 26 which indicate that the purported electronic screens “may form a repeated image or the individual images may form a mosaic of a larger image” (emphasis added). Based on the specification (as would be understood by a person having ordinary skill in the art), the terms “repeated images” plainly refers to temporally -- and not spatially -- repeated images.

In this regard, the law does not provide for specification terms, which are plainly supported, to ignore the reasonable interpretation of “repeated images”, as provided for in the context of the claims, and as would be understood by a person having ordinary skill in the art based on the specification. (See In re Weiss, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must “look to the specification for the meaning ascribed to that term”; Board reversed) (unpublished decision); In re Okuzawa, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) (“claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest *reasonable* interpretation”; Board reversed; emphasis in original) (citing In re Royka, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are “not to be read in a vacuum and while it is true that they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a

part”; Board reversed; emphasis in original); and *In re Rohrbacher*, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an “applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification”; Board reversed)). It is respectfully submitted that this is exactly the case here since contrary to the foregoing law, the Supplemental Answer and the Office Actions to date simply reflects an unreasonable reading of “repeated images” without regard to the sense in which those terms are used in the specification.

In short, it is clear from the specification of the present application that the claimed repeated display occurs over time, and it is therefore submitted that the combined Tapp and Quirk references do not disclose or suggest all of the features of claim 1, which is therefore allowable over the references relied upon.

*In short, it is respectfully submitted that the secondary “Quirk” reference does not cure the critical deficiencies of the “Tapp” reference. This is because “Quirk” repeats the images spatially on several displays and therefore shows the same image on several displays at the same time—and not temporally repeated images.*

Claims 2 and 3 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Independent claims 5 and 6 as presented also include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

It is therefore respectfully requested that the obviousness rejections of claims 1 to 3, 5 and 6 be reversed.

### **C. Claims 1 to 15**

#### **The Rejections Under 35 U.S.C. § 103(a) That Claims 1 to 15 Are Obvious Over “Tapp” in view of the “Johnson” Reference**

#### **Claims 1 to 15**

*It is first noted that the Supplemental Answer at pages 7 and 8 does not even identify a motivation for combining the Tap and Johnson references. Again, the Examiner simply does so without any rationale for doing so, except to assert that doing so provides the claim feature except to assert that doing so provides the claim features In fact, at page 12, the*

Examiner essentially asserts that the suggestion is provided by the fact that because Tapp "suggests" that the systems are applicable to other systems, this is sufficient to provide the motivation to provide the claimed subject matter. This does not represent the requisite suggestion or motivation.

*In particular, the "Johnson" reference addresses an entirely different problem, so that a person having ordinary skill in the art would not have any motivation to combine "Tapp" and "Johnson". Even if combined, a person having ordinary skill in the art would not obtain the claimed subject matter because the secondary "Johnson" reference does not cure the critical deficiencies of the primary "Tapp" reference. In particular, the "Johnson" reference does not disclose or suggest the feature of repeatedly displaying a sequence. Instead, the "Johnson" reference refers to displaying each buffer only once and not repeatedly (see Figures 4a and 4b). Also, the graphic refresh of "Johnson" is not performed upon the occurrence of an event.*

Also, regarding the primary Tapp reference, as explained above, the Supplemental Answer and the Office Actions to date essentially admit that the reference does not disclose the feature of repeatedly displaying a sequence as provided for in the context of claim 1.

The Supplemental Answer and the Office Actions to date essentially admit that the primary reference does not repeatedly display a sequence as provided for in the context of the claim. The secondary Johnson reference does not cure this critical deficiency since even if it were proper to combine the reference (which it is not), the "graphics refresh" feature purportedly described in the Johnson reference is not performed upon the occurrence of the event as is the repetition of the display as in claim 1.

Still further, the secondary reference does not even concern security systems, and is only directed to providing buffers for a video system, in which only one of the video data portions in the buffer is selectively displayed to provide non-genlocked (non-synchronized) live video on a computer system. Thus, the secondary reference is directed to addressing an entirely different problem than is addressed by the presently claimed subject matter in which a sequence formed by a plurality of images is displayed upon occurrence of the event.

That is, the primary Tapp reference does not disclose using a repetition of images pertinent to a security-threatening event (such as, for example, images of the pertinent

location from before and after an event) to cause alarm and promote security. The Johnson reference similarly does not disclose or suggest repeating images pertinent to a security-threatening event to cause alarm and promote security. Accordingly, the combination of Tapp and Johnson does not disclose or suggest this important aspect of the claimed subject matter.

Accordingly, claim 1 is allowable.

Claims 2 to 4, 7, 10 and 13 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Independent claims 5 and 6 as presented also include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

Claims 8, 11 and 14 depend from claim 5 and are therefore allowable for the same reasons as claim 5.

Claims 9, 12 and 15 depend from claim 6 and are therefore allowable for the same reasons as claim 6.

It is therefore respectfully requested that the obviousness rejections be withdrawn, since claims 1 to 15 are allowable.

Accordingly, claims 1 to 15 are allowable, and it is therefore respectfully requested that the all of the obviousness rejections be reversed.


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CONCLUSION

In view of the above, it is plain that the Supplemental Answer has not properly established that the rejections of the claims should be affirmed. It is therefore respectfully requested that the rejections of the finally rejected claims 1 to 15 be reversed, and that these claims be allowed as presented.

Respectfully submitted,

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